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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
LAZARO, DAVID R	

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/993,979	BREBNER, GAVIN	
	Examiner	Art Unit	
	David Lazaro	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the amendment filed 6/13/05.

2. Claims 1-5, 8, 10, 12 and 15-20 were amended.

3. Claims 1-20 are pending in this office action.

Response to Amendment

4. The objections to claims 3, 4, 16, 17 and 20 are withdrawn.

5. The rejection of claims 5, 10, 15, 17 and 18 under 35 U.S.C. §112, second paragraph, are withdrawn.

6. The rejection of claims 16, 19 and 20 under 35 U.S.C. §101 are withdrawn.

7. Applicant's arguments filed 06/13/2005 have been fully considered but they are not persuasive (See Response to Arguments). The grounds of rejection are respectfully maintained as set forth in the last Office Action mailed on 03/08/2005.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3 and 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,867,714 by Todd et al. (Todd).

10. With respect to Claim 1, Todd teaches a process for automatically monitoring the hardware resources of a computer, comprising: initiating a monitoring agent (Col. 6 lines 42-56) for analyzing the software packages installed into said computer and for elaborating a direct representation of said analysis (Col. 6 lines 42-56); initiating a connection to a conformity server connected to an Internet or Intranet network for transmitting said direct representation of the software package, together with data representative of the actual hardware configuration of said computer (Col. 11 line 66 - Col. 12 line 8); elaborating in said conformity server an ideal hardware configuration and comparing said ideal configuration to said actual configuration (Col. 11 lines 66 - Col. 12 line 8, and Col. 12 lines 30-57); and in response to said comparison, transmitting information to said monitoring agent so that the latter can initiate a business transaction with an external server (Col. 12 lines 30-57).

11. With respect to Claim 2, Todd teaches a process executed in a computer for automatically monitoring the hardware resources existing in said computer, comprising: initiating a monitoring agent for the purpose of analyzing the software package which are installed into said computer and for elaborating a direct representation of said analysis (Col. 6 lines 42-56); initiating a connection to a conformity server connected to an Internet or Intranet network for the purpose of receiving data representative of typical hardware configurations and for deriving an ideal hardware configuration (Col. 11 line 66 - Col. 12 line 8); initiating a determination of the actual hardware resources for the purpose of a comparison to said ideal hardware configuration (Col. 11 lines 66 - Col. 12

line 8, and Col. 12 lines 30-57); and informing when necessary the user of the lack of hardware resources reported by said determination step (Col. 12 lines 30-57).

12. With respect to Claim 3, Todd teaches all the limitations of Claim 1 and further teaches said monitoring agent connects to an external accessory server and transmits a request containing information representative of the actual and ideal hardware resources to the external accessory server for the purpose of preparing and completing a transaction (Col. 12 lines 30-57 and Col. 13 lines 16-29).

13. With respect to Claim 15, Todd teaches all the limitations of Claim 3 and further teaches said conformity server and said accessories server are grouped in order to form an unique server to which said monitoring agent can post request (Col. 12 lines 30-57 and Col. 13 lines 16-29).

14. With respect to Claim 16, Todd teaches a transaction aid for assisting a transaction between an user and at least one remote server, the or each said remote server being prepared to process at least one predetermined command (Col. 12 lines 3-57), said transaction aid comprising a computer readable medium having program code elements encoded thereon for carrying a method as claimed in claim 1 (Claim 16 is rejected based on the same reasoning given in the rejection of Claim 1, see paragraph 12 above).

15. With respect to Claim 17, Todd teaches an Apparatus comprising a transaction aid as claimed in claim 16 implemented as a local agent for execution on a personal computer (Col. 6 lines 42-56 and Col. 13 lines 16-29).

16. With respect to Claim 18, Todd teaches an apparatus as claimed in claim 17 wherein the local agent is preloaded and arranged to execute when the personal computer is booted (Co. 13 line 62 - Col. 14 line 14).

17. With respect to Claim 19, Todd teaches a transaction aid computer program product comprising a computer readable medium having program code elements encoded thereon for carrying out a method as claimed in claim 1 (Claim 19 is rejected based on the same reasoning given in the rejection of Claim 1, see paragraph 12 above).

18. With respect to Claim 20, Todd teaches a transaction aid computer program product as claimed in claim 19 in the form of an agent (Col. 6 lines 42-56 and Col. 13 lines 16-29).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Todd in view of "XML As a Representation for Management Information - A White Paper: Version 1.0", published September 15th, 1998, by Desktop Management Task Force, Inc. (hereinafter DMTF).

21. With respect to Claim 4, Todd teaches all the limitations of Claim 3 but does not explicitly disclose the information received from the conformity server is formatted in the XML Extended Markup Language which is associated to Document Type Definition (DTD) file. DMTF teaches information can be formatted the XML Extended Markup Language which is associated to Document Type Definition (DTD) file (Pages 2-4, 'Overview').

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the process disclosed by Todd and modify it as indicated by DMTF such that the information received from the conformity server is formatted in the XML Extended Markup Language which is associated to a Document Type Definition (DTD) file. One would be motivated to have this, as use of XML can reduce processing overhead and allows for interoperation between systems regardless of the underlying platform and/or operating environment (Pages 2-3, 5th paragraph of 'Overview' that starts with "Management information...").

22. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd in view of DMTF as applied to claim 4 above, and further in view of U.S. Patent 6,230,199 by Revashetti et al. (Revashetti).

23. With respect to Claim 5, Todd in view of DMTF teaches all the limitations of Claim 4 and further teaches the operating system is a windows type operating system (Col. 11 lines 33-40 and Col. 12 lines 35-42 of Todd).

Todd in view of DMTF does not explicitly disclose the analysis of the software packages configuration is based on an analysis of the registry. Revashetti teaches the analysis of the software packages configuration of a computer can be based on the registry (Col. 11 lines 5-16 and lines 48-62).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the process disclosed by Todd in view of DMTF and modify it as indicated by Revashetti such that the operating system is a type of operating system having a registry and that the analysis of the software packages configuration is based on an analysis of the registry. One would be motivated to have this, as it is desirable to ensure provided product information is based upon the individual user's computing environment configuration (Col. 3 lines 6-10 and Col. 11 lines 5-16 and lines 48-62 of Revashetti).

24. With respect to Claim 6, Todd in view of DMTF and in further view of Revashetti teaches all the limitations of claim 5 and further teaches the analysis of the software packages configuration is based upon the systematic research of the file types which are loaded onto the hard disk drive (Col. 11 lines 5-16 and lines 30-47 of Revashetti).

25. Claims 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd in view of U.S. Patent 6,314,565 by Kenner et al. (Kenner).

26. With respect to Claim 7, Todd teaches all the limitations of Claim 1 and further teaches a request transmitted to the conformity server (Col. 11 line 66 - Col. 12 line 8) contains information representative of the type or model of the computer (Col. 6 lines

42-67). Todd further teaches indifference to the mode of communications used (Col. 6 lines 31-41) and suggests the use of the Internet to connect the computer to the conformity server (Col. 13 lines 5-15).

Todd does not explicitly teach the request conforming to the Hypertext Transfer Protocol (HTTP). Kenner teaches the use of HTTP and HTML are common modes of internet communications (Col. 1 lines 38-60 and Col. 2 lines 6-32). Kenner teaches a request transmitted to a server that conforms to HTTP and includes information related to the request (Col. 10 lines 5-29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the process disclosed by Todd and modify it as indicated by Kenner such that said request transmitted to said conformity server conforms to the Hypertext Transfer Protocol (HTTP), and contains a query string containing information representative of the type or model of the computer. One would be motivated to have this, as HTTP is a commonly known way to transmit and access information on networks such as the internet (Col. 1 lines 34-60 of Kenner).

27. With respect to Claim 8, Todd teaches all the limitations of Claim 3 and further teaches a request transmitted to the accessory server (Col. 12 lines 30-57 and Col. 13 lines 16-29) contains information extracted from a local profile and representative of the actual hardware resources (Col. 6 lines 42-67 and Col. 12 lines 30-57). Todd further teaches indifference to the mode of communications used (Col. 6 lines 31-41) and suggests the use of the Internet to connect the computer to the accessory server (Col. 13 lines 5-15).

Todd does not explicitly teach the request conforming to the Hypertext Transfer Protocol (HTTP). Kenner teaches the use of HTTP and HTML are common modes of internet communications (Col. 1 lines 38-60 and Col. 2 lines 6-32). Kenner teaches a request transmitted to a server that conforms to HTTP and includes information related to the request (Col. 10 lines 5-29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the process disclosed by Todd and modify it as indicated by Kenner such that said request transmitted to said accessory server conforms to the Hypertext Transfer Protocol (HTTP), and contains a query string containing information extracted from a local profile and representative of the actual hardware resources. One would be motivated to have this, as HTTP is a commonly known way to transmit and access information on networks such as the internet (Col. 1 lines 34-60 of Kenner).

28. With respect to Claim 9, Todd in view of Kenner teaches all the limitations of Claim 8 and further teaches said local profile contains profile data that are representative of platform configuration, and are extracted from information available at the Basic Input Output System (BIOS) level (Col. 11 lines 43-58 of Todd).

29. With respect to Claim 10, Todd in view of Kenner teaches all the limitations of Claim 8 and further teaches said profile data are collected by means of interrogation of standardized systems management interfaces present in the computer (Col. 11 lines 43-58 of Todd).

30. With respect to Claim 11, Todd in view of Kenner teaches all the limitations of Claim 8 and further teaches said profile parameters are collected by means of an

interrogation via the Distributed Management Interface (DMI) or Window management Interface (WMI) (Col. 11 lines 43-58 of Todd).

31. With respect to Claim 12, Todd in view of Kenner teaches all the limitations of Claim 8 and further teaches said monitoring agent receives the response from said accessory server under the form of a Hypertext Markup language (HTML) page, and pushes it to a web browser for allowing the completion of the transaction between the user and the server (Col. 10 lines 5-29 and Col. 1 lines 33-60 of Kenner).

32. With respect to Claim 13, Todd teaches all the limitations of Claim 3 but does not explicitly disclose the conformity server posts a list of accessory servers to which the request transmitted by said agent can be mapped thereby permitting modification of the offers that can be made to the user. Kenner teaches the use of a list of servers to which a request can be mapped thereby permitting modification of the offers that can be made to the user (Col. 10 lines 5-29 of Kenner).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the process disclosed by Todd and modify it as indicated by Kenner such that the conformity server posts a list of accessory servers to which the request transmitted by said agent can be mapped thereby permitting modification of the offers that can be made to the user. One would be motivated to have this as it is desirable to have a user-friendly diagnostic process that is functional to a user specific system (Col. 1 lines 46-54 and Col. 3 lines 1-8 of Todd).

33. With respect to Claim 14, Todd teaches all the limitations of Claim 1 and further teaches the monitoring agent may be a software program (Col. 6 lines 43-56). Todd

does not explicitly disclose the monitoring agent is downloaded from said conformity server. Kenner teaches a monitoring agent that can be downloaded from a server (Col. 6 line 56-66 and Col. 9 lines 3-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the process disclosed by Todd and modify it as indicated by Kenner such that said monitoring agent is downloaded from said conformity server. One would be motivated to have this, as it is desirable to keep the monitoring agent and related processes up to date in a relatively easy fashion (Col. 9 lines 3-9 of Kenner).

Response to Arguments

34. Applicant's arguments filed 06/13/05 have been fully considered but they are not persuasive.

35. Applicant argues on page 9 - "*Applicant submits that this is most definitely not anticipatory of the claimed elaborating in a conformity server an ideal hardware configuration for a computer and comparing the ideal configuration to the actual configuration of the computer. Although it is possible that, with the benefit of hindsight and after having read Applicant's claims, the disclosure of Todd may be seem as somewhat related to the present invention, Applicant submits that the disclosure of Todd falls far short of rendering the present invention obvious to person skilled in the art, and even more so of outright anticipating the present invention. There is nothing in Todd that would urge a skilled person to consider analyzing the software installed in a computer, then elaborating an ideal hardware configuration for running all this software. At most, Todd can be understood as teaching the possibility of targeted advertising: "The remote data source 130 may further include promotional data. The promotional. data is not used for solving problems that the user may have, but, instead, is directed to*

communicating opportunities to the user in a targeted fashion." (col. 12, 11. 30-34, emphasis added). There is simply nothing in Todd that even hints at the present invention's overarching goal of determining the ideal hardware configuration required to run a particular software package."

a. Claim 1 states, "elaborating in said conformity server an ideal hardware configuration and comparing said ideal configuration to said actual configuration". Giving a broadest reasonable interpretation as noted in MPEP 2111, the teachings of Todd are clearly within the scope of this limitation. Todd states in Col. 12 lines 40-42 "The remote data source 130 may suggest that the user obtain an upgrade on the processor and memory, given that the user is running Word for Windows 6.0". The remote data source (conformity server) makes this suggestion based on the user's actuation configuration, for example as listed in Col. 12 lines 35-39. This alone is sufficient to be within the scope of "elaborating in said conformity server an ideal hardware configuration and comparing said ideal configuration to said actual configuration" as the server is comparing an ideal configuration to an actual configuration in order to determine what upgrades the user should obtain. Furthermore, Todd states "the remote data source 130 may adjust its processor and memory upgrade suggestions **as a function** of the amount of time the user actually spends running Word for Windows 6.0, as opposed to one of the other application programs"(Col. 12 lines 44-49, emphasis added). It is clear that the server disclosed by Todd is actively determining (elaborating) an ideal configuration and making suggestions based the actual configuration compared with the ideal configuration. Applicant continually

asserts that the teachings of Todd do not anticipate the "*overarching goal of determining the ideal hardware configuration required to run a particular software package*" yet Applicant has provided no factual evidence or reasoning as to how the claim language is particularly distinguished from teachings of Todd. As such, Applicant's arguments are not persuasive.

b. Furthermore, applicant states in part "*Although it is possible that, with the benefit of hindsight and after having read Applicant's claims, the disclosure of Todd may be seem as somewhat related to the present invention...*". The examiner notes hindsight is typically argued in the case of an obviousness rejection. If anything, a hindsight argument in relation to an anticipation rejection is supportive of the fact that the claims have been given the broadest reasonable interpretation.

c. Furthermore, applicant states "*There is nothing in Todd that would urge a skilled person to consider analyzing the software installed in a computer, then elaborating an ideal hardware configuration for running all this software.*" As described above, Todd specifically discloses analysis of software installed in a computer (Word for Windows 6.0), even including analysis of the usage of the software, and forms an ideal configuration on the basis of such analysis in order to suggest upgrades for the use (Col. 12 lines 30-57),

d. Furthermore, applicant states "*At most, Todd can be understood as teaching the possibility of targeted advertising:...*". Even if the suggested purpose of the invention of Todd is akin to targeted advertising, the form this

"promotional data" takes is on the basis of determining an ideal configuration and comparing it to an actual configuration. In other words, the claimed subject matter is not distinguished from the teachings of Todd just because the functionality may be directed towards "communicating opportunities to the user in a targeted fashion. In fact, the claimed subject matter of the instant application itself implies the communication of opportunities to the user through the initiating of a "business transaction".

36. Applicant argues on page 10 - "*Todd does remark, off-handedly, that the "remote data source 130 may also be employed in an automated ordering process, wherein the user can automatically order processor or memory upgrades, for example, without having to interact with sales personnel." However, the remote data source has been likened by the Examiner to the presently claimed conformity server, and thus it cannot possibly be understood as teaching that the monitoring agent, which resides on the computer, can initiate a business transaction with an external server.*"

e. The examiner interprets the suggested upgrades (the result of a comparison between the ideal configuration and the actual configuration) sent to the computer system on which the monitoring agent resides as being the transmitted information. Subsequently, in response to this information, a business transaction can be initiated to order the suggested upgrades. The examiner considers this to be within the scope of the claimed subject matter based on a broadest reasonable interpretation. In addition, the "automated ordering process" itself implies that information has to be sent to the computer on which the monitoring agent resides in order for a business transaction to be

initiated and that the transaction clearly occurs with an external server, which could include the remote data source. How else would the user be informed of the suggested upgrades and subsequently initiate an associated business transaction. Furthermore, Col. 13, lines 16-29, describes the various configurations the overall system can take, including conventional processing systems and network combinations. It is clear that, based on the teachings of Todd, one of ordinary skill in the art would anticipate the transmission of information to the monitoring agent so that the monitoring agent can initiate a business transaction with an external server. Applicant's arguments are not persuasive.

37. Applicant argues on page 10 - *"Todd does not inform the user of such a lack of resources, because Todd does not derive an ideal configuration for the user's computer. As discussed, all Todd informs the user of are promotional opportunities, i.e. advertising."*

f. The examiner interprets the suggestions to upgrade parts or to "replace the computer system" (Col. 12 lines 49-52), as informing the user of the lack of hardware resources in relation to what the ideal configuration should be. The examiner considers this to be sufficiently within the scope of the limitation "informing when necessary the user of the lack of hardware resources reported by said determination step". As noted before, the claimed subject matter is not distinguished from the teachings of Todd just because the functionality may be

directed towards "communicating opportunities to the user in a targeted fashion. In fact, the claimed subject matter of the instant application itself implies the communication of opportunities to the user through the initiating of a "business transaction". Applicant's arguments are not persuasive.

Conclusion

38. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Lazaro
August 24, 2005

SALEH NAJJAR
PRIMARY EXAMINER